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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/591,534   | 09/01/2006  | Guenter Hauke        | MERCK-3235          | 2982             |
| 23599 7590 04/01/2008<br>MILLEN, WHITE, ZELANO & BRANIGAN, P.C.<br>2200 CLARENDON BLVD.<br>SUITE 1400<br>ARLINGTON, VA 22201 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| GERIDO, DWAN A   |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/591,534

**Applicant(s)**

HAUKE ET AL.

**Examiner**

Dwan A. Gerido, Ph.D.

**Art Unit**

4151

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 01 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 2-2-2007  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Inventor's Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112.***

1. Claim 1 is objected to because of the following informalities: claim 1 recites “consists essentially of”. Appropriate correction is required.
2. Claim 5 recites the limitation "the solids content" in line 2. There is insufficient antecedent basis for this limitation in the claim.
3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites improper Markush language as the alternative expressions are unclear as put forth in claim 6 (see MPEP 2173.05 h).
4. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1-5 recites the broad recitation

“characterized in”, and the claim also recites “consists of” which is the narrower statement of the range/limitation.

5. Claim 9 provides for the use of a means for covering specimens, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

6. Claim 9 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 5, 6, and 8 rejected under 35 U.S.C. 102(b) as being anticipated by Fischer et al., (US 4,302,480).

9. For claims 1 and 2 Fischer et al teach a cover slip with a layer thickness ranging between 0.05 - 0.15mm (column 3 lines 37-38). The layer thickness as taught by Fischer et al., is within the range of that of the instant claim; therefore, the layer would be capable of being applied at a tolerance of  $\pm 0.1$  or  $\pm 0.05$ mm.

10. With regards to claim 5, Fischer et al., does not specifically indicate the solids content of the covering medium in the dried state. However, Fischer et al., does teach a covering medium identical to that of the instant application (polyvinylpyrrolidone, column 3 lines 43-44). Because the covering medium of the prior art and the instant application are identical, one of ordinary skill would recognize that the covering mediums would exhibit identical characteristics and properties.

11. For claim 6, Fischer teaches a process of adding the covering medium to the cover slip by printing techniques (column 5 lines 61-62). The printing technique of Fischer would be fully capable of applying the covering media with a layer thickness of  $\pm 0.1$ .

12. For claim 8, Fischer teaches applying the covering medium by screen printing. (column 5 line 62).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 3, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer et al., (US 4,302,480).

17. With regards to claim 3, Fischer et al., teach a cover slip for microscope slides wherein the thickness of the covering medium layer ranges from 0.05mm – 0.15mm (column 3 lines 37-38). The instant claim recites a thickness of “about 2mm” which implies variability in the thickness of the layer (See MPEP 2144.05 Section II).

18. With regards to claim 9, Fischer et al., teach a cover slip for microscope slides and a covering medium applied to the cover slip (column 3 lines 33-36). Fischer et al., is silent as to the mechanism in which the cover slips are applied to the slide; however, one of ordinary skill in the art would recognize that the cover slips could be manually applied to the microscope slides in order to cover the specimen placed on the slide.

19. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer et al., (US 4,302,480) in view of Pickett (US 3,498,860).

20. With regards to claim 4, Fischer et al., teach a cover slip for microscope slides and a covering medium applied to the cover slip (column 3 lines 33-36). Fischer et al., does not teach

the cover slip made of glass. Pickett teaches a process of preparing a glass cover slip for microscope slides with a covering medium (column 2 lines 44-45, column 3 lines 6-12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the glass cover slip of Pickett with the microscope slide of Fischer et al., in order to provide a more rigid protective cover for the specimen sample on the slide.

21. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer et al (US 4,302,480) in view of Markovits et al., (US 4,011,350).

22. With regards to claim 7, Fischer et al., teach a cover slip for microscope slides and a covering medium applied to the cover slip (column 3 lines 33-36). Fischer et al., does not teach applying the covering medium with a dispensing needle. Markovits et al., teach a method of making a microscope slide system in which a dispensing needle is used to apply a reagent to the slide (column 7 line 11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the dispensing needle of Markovits et al., in lieu of the printing technique of Fischer et al., in order to apply a specific volume of covering medium to an individual cover slip as the volume of covering medium may alter stability of the microscope slide.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwan A. Gerido, Ph.D. whose telephone number is (571)270-3714. The examiner can normally be reached on Monday – Friday, 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mikhail Kornakov can be reached on (571) 272-1303. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DAG

/Michael Kornakov/  
Supervisory Patent Examiner, Art Unit 4151